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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/799,048	03/11/2004	Shubhasheesh Anand	50269-0578	6738
73066 7590 09/03/2008 HICKMAN PALERMO TRUONG & BECKER LLP/Yahoo! Inc. 2055 Gateway Place Suite 550 San Jose, CA 95110-1083				
			EXAMINER	
			STIBLEY, MICHAEL R	
			ART UNIT	PAPER NUMBER
			3688	
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			09/03/2008 PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/799,048

Applicant(s)

ANAND ET AL.

Examiner

MICHAEL R. STIBLEY

Art Unit

3688

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 June 2008 and 21 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5, 6, 8-10, 12, 13, 18-21 and 25-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 6, 8-10, 12, 13, 18-21 and 25-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-848)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This Office Action is in response to the application filed originally on 3/11/2004, as amended on 3/21/2008 in response to a non-final office action dated 1/15/2008 and as amended on 6/24/2008 in response to a restriction requirement of 6/20/2008.

CLAIM STATUS

2. Claims 1-3, 5-6, 8-10, 12-13, 18-21, 25-28, and 29-34 are currently pending in the instant application and have been examined. Applicant elected group I, Claims 1-3, 5-6, 8-10, 12-13, 18-21 and 25-28, *without traverse*, and subsequently added new claims 29-34. Claims 4, 7, 11, 14-17, and 22-24 have been cancelled by Applicant.

Response to Arguments

3. Applicant's arguments of 3/21/2008 with respect to claims 1-3, 5-6, 8-10, 12-13, 18-21 and 25-28 have been considered but are moot in view of the new ground(s) of rejection.

Information Disclosure Statement

4. The information disclosure statement filed 5/28/2008 fails to comply with 37 CFR 1.98(a)(1), which requires the following: (1) a list of all patents, publications, applications, or other information submitted for consideration by the Office; (2) U.S. patents and U.S. patent application publications listed in a section separately from citations of other documents; (3) the application number of the application in which the information disclosure statement is being

submitted on each page of the list; (4) a column that provides a blank space next to each document to be considered, for the examiner's initials; and (5) a heading that clearly indicates that the list is an information disclosure statement. The information disclosure statement has been placed in the application file, but the information referred to therein has not been considered. Examiner recommends use of Form PTO-1449 for disclosure of PTO Correspondence.

Claim Objections

5. 37 C.F.R. § 1.75 Claim(s) provides:

- (a) The specification must conclude with a claim particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention or discovery.
- (b) More than one claim may be presented provided they differ substantially from each other and are not unduly multiplied.
- (c) One or more claims may be presented in dependent form, referring back to and further limiting another claim or claims in the same application. Any dependent claim which refers to more than one other claim ("multiple dependent claim") shall refer to such other claims in the alternative only. A multiple dependent claim shall not serve as a basis for any other multiple dependent claim. For fee calculation purposes under § 1.16, a multiple dependent claim will be considered to be that number of claims to which direct reference is made therein. For fee calculation purposes also, any claim depending from a multiple dependent claim will be considered to be that number of claims to which direct reference is made in that multiple dependent claim. In addition to the other filing fees, any original application which is filed with, or is amended to include, multiple dependent claims must have paid therein the fee set forth in § 1.16(j). Claims in dependent form shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim. A multiple dependent claim shall be construed to incorporate by reference all the limitations of each of the particular claims in relation to which it is being considered.

6. Claims 8-10, 12-13, 25-28 and 32-34 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Claims 8-10, 12, 13, 25-28, and 32-34 are product claims (i.e. computer-readable media) that refers back to method Claims 1-3, 5, 6, 18-21, and 29-31. The Office considers any claim that refers to another claim as dependent thereon, i.e. a dependent claim. Since the parent claims are method claims comprising a series of steps and the above claims fail to add, delete, or change any of these steps, the above claims fail to further limit their parent claims. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. **Claims 1-3, 5-6, 18-21 and 29-31 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

As per Claims 1-3, 5-6, 18-21 and 29-31: Claims 1-3, 5-6, 18-21 and 29-31 are rejected under 35 U.S.C. 101 as drawn to a non-statutory subject matter. The claims (or at least independent claims 1 and 18, uncured by the dependent claims) are related to mental processes, which is not patentable. Indeed, the claims (e.g. claims 1 and 18) recite a (mental) process, which is not tied to another statutory class or does not change or switch statutory class (such as a particular apparatus) or does not transform the underlying subject matter (such as an article or

materials) to a different state or thing. See MPEP §2106.IV.B: *Determine Whether the Claimed Invention Falls Within An Enumerated Statutory Category*. See also the following U.S. Supreme Court cases: *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); and *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. **Claims 1-3, 5-6, 8-10, 12-13, 18-21 and 25-34 are rejected under 35 U.S.C. 102(e) as being anticipated by Dorab Patel et al (PATEL)(US 2004/0103024 A1).**

As per Claim 1: PATEL teaches: A method for determining which advertisements to include with electronic content delivered to users over a network, comprising an electronic content provider: See at least ¶¶153, 659 receiving a plurality of advertisements from a plurality of advertisers; See at least ¶¶3, 6, 24, 63, 139, 202, Fig 12, Fig 13,

storing revenue information that indicates potential revenue amounts for the plurality of advertisements, wherein each of the plurality of advertisements is associated with corresponding delivery criteria; See at least ¶¶673, 13, 59

associating each of the plurality of advertisements with a priority class, wherein the priority class associated with each of the plurality of advertisements indicates whether the corresponding advertisement is the subject of a guaranteed contract; See at least ¶¶139, 13-17

receiving, from a client that is not one of the plurality of advertisers, a request to provide over the network a piece of electronic content that includes a slot for an advertisement; See at least ¶¶7, 8, 153, 694, 696, 697,

and in response to receiving the request, performing the steps of: comparing slot attributes of the slot with the delivery criteria of the plurality of advertisements to determine a subset of the plurality of advertisements that qualify for inclusion in the slot, wherein the slot attributes of the slot include at least one of (a) the nature of the piece of electronic content, (b) the size of the slot within the piece of electronic content, or (c) the placement of the slot within the piece of electronic content; See at least ¶¶7, 23, 36 [advertisements are reviewed as objectionable or not (nature) and published or not based on this comparison] See also ¶¶18, 138, 179, 206,

filtering, out of the subset of the plurality of advertisements, advertisements that have a priority class that is lower than the priority class of any other advertisement that belongs to the subset; See at least ¶¶96, 131, 206, 208,

selecting an advertisement from the subset of advertisements to include in the slot based, at least in part, on the potential revenue amounts. [matching of advertiser issued offers and publisher issued bids] See at least ¶¶231, 523-525

As per Claim 2: PATEL teaches: wherein: each advertisement of the plurality of advertisements has a corresponding delivery obligation and a corresponding potential revenue amount. See at least ¶17

As per Claim 3: PATEL teaches: wherein the selecting an advertisement to include further comprises: selecting a first advertisement instead of a second advertisement if the corresponding potential revenue amount of the first advertisement is higher than the corresponding potential revenue amount of the second advertisement. See at least ¶525

As per Claim 5: PATEL teaches: wherein the piece of electronic content is a web page. See at least ¶5

As per Claim 6: PATEL teaches: wherein the piece of electronic content is a video stream. See at least ¶¶707, 59

As per Claim 8: PATEL teaches: A computer-readable storage medium storing one or more sequences of instructions which, when executed by one or more processors, causes the one or more processors to perform the method recited in Claim 1. See at least ¶59

As per Claim 9: PATEL teaches: A computer-readable storage medium storing one or more sequences of instructions which, when executed by one or more processors, causes the one or more processors to perform the method recited in Claim 2. See at least ¶59

As per Claim 10: PATEL teaches: A computer-readable storage medium storing one or more sequences of instructions which, when executed by one or more processors, causes the one or more processors to perform the method recited in Claim 3. See at least ¶59

As per Claim 12: PATEL teaches: A computer-readable storage medium storing one or more sequences of instructions which, when executed by one or more processors, causes the one or more processors to perform the method recited in Claim 5. See at least ¶59

As per Claim 13: PATEL teaches: A computer-readable storage medium storing one or more sequences of instructions which, when executed by one or more processors, causes the one or more processors to perform the method recited in Claim 6. See at least ¶59

As per Claim 18: PATEL teaches: See the reasoning of the rejection of Claim 1, as the limitations of Claim 18 are substantially similar to those of Claim 1. In addition see at least: ¶¶ 131, 132, 673, 226, 141

As per Claim 19: PATEL teaches: wherein the selecting an advertisement to include is based on the priority classes if the slot is reserved for the buyers that satisfy the set of criteria. See at least ¶¶131, 132

As per Claim 20: PATEL teaches: wherein the selecting an advertisement to include is based on the potential revenue amounts if the slot is not reserved for buyers that are not required to satisfy the set of criteria. See at least ¶¶131,132

As per Claim 21: PATEL teaches: wherein the selecting an advertisement to include further comprises: selecting a first advertisement instead of a second advertisement if the corresponding potential revenue amount of the first advertisement is higher than the corresponding potential revenue amount of the second advertisement. See at least ¶206

As per Claim 25: PATEL teaches: A computer-readable storage medium storing one or more sequences of instructions which, when executed by one or more processors, causes the one or more processors to perform the method recited in Claim 18. See at least ¶59

As per Claim 26: PATEL teaches: A computer-readable storage medium storing one or more sequences of instructions which, when executed by one or more processors, causes the one or more processors to perform the method recited in Claim 19. See at least ¶59

As per Claim 27: PATEL teaches: A computer-readable storage medium storing one or more sequences of instructions which, when executed by one or more processors, causes the one or more processors to perform the method recited in Claim 19. See at least ¶59

As per Claim 28: PATEL teaches: A computer-readable storage medium storing one or more sequences of instructions which, when executed by one or more processors, causes the one or more processors to perform the method recited in Claim 21. See at least ¶59

As per Claim 29: PATEL teaches: further comprising: exclusively offering a first portion of an inventory, of advertisement slots in electronic content, to buyers that satisfy a set of criteria; and offering a second portion of the inventory to buyers that are not required to satisfy the set of criteria, wherein the buyers that satisfy the set of criteria and the buyers that are not required to satisfy the set of criteria are advertisers that provide advertisements. See at least ¶¶8, 13, 18, 46, 51, 58, 117.

As per Claim 30: PATEL teaches: further comprising: offering less than the entirety of the second portion of the inventory for purchase to the buyers that are not required to satisfy the set of criteria. See at least ¶¶8, 13, 18, 46, 51, 58, 117.

As per Claim 31: PATEL teaches: further comprising: setting an initial price that the buyers are allowed to bid on the second portion of the inventory. See at least ¶¶8, 13, 18, 46, 51, 58, 117, 590

As per Claim 32: PATEL teaches: A computer-readable storage medium storing one or more sequences of instructions which, when executed by one or more processors, causes the one or more processors to perform the method recited in Claim 29. See at least ¶59

As per Claim 33: PATEL teaches: A computer-readable storage medium storing one or more sequences of instructions which, when executed by one or more processors, causes the one or more processors to perform the method recited in Claim 30. See at least ¶59

As per Claim 34: PATEL teaches: A computer-readable storage medium storing one or more sequences of instructions which, when executed by one or more processors, causes the one or more processors to perform the method recited in Claim 31. See at least ¶59

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

McElfresh et al (US 7,373,599 B2) provides for a Method and System for Optimum Placement of Advertisements on a webpage.

McElfresh et al (US 7,100,111 B2) provides for a Method and System for Optimum Placement of Advertisements on a webpage.

McElfresh et al (US 6,907,566 B1) provides for a Method and System for Optimum Placement of Advertisements on a webpage.

Graham et al (US 6,804,659 B1) provides for Content Based Web Advertising.

Gupta et al (US 6,487,538 B1) provides for Method and Apparatus for Local Advertising.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL R. STIBLEY whose telephone number is (571) 270-3612. The examiner can normally be reached on Monday-Friday 9 a.m.-5 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JAMES W. MYHRE can be reached on (571) 272-6722. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/MICHAEL R. STIBLEY/
Examiner, Art Unit 3688
Tuesday, September 02, 2008

/James W Myhre/
Supervisory Patent Examiner, Art Unit 3688